

## **REMARKS**

### **I. Introduction**

Claims 11-12 and 16-18 are pending in this application. Claim 11 has been amended. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

### **II. Rejection of Claims 11-12 and 16-18 Under 35 U.S.C. § 103(a)**

Claims 11-12 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. JP2001198141A to Kudo et al. (hereinafter “Kudo”) in view of U.S. Patent No. 6,081,371 to Shioda et al. (hereinafter “Shioda ‘371”) and U.S. Patent Application Publication No. 2001/0055062A1 to Shioda et al. (hereinafter “Shioda ‘062”). The Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

In support of the rejection, the Examiner makes the following contentions in the Advisory Action: a) “even a light which provides illumination to the room will also provide some light onto the subject of observation”; and b) Shioda’062 discloses that “in fig. 52, the auxiliary microscope (401) clearly images portion P, therefore the auxiliary microscope is located such that the laser light irradiating portion P (the subject of observation) is visible.” Applicants respectfully submit that the teachings of the applied references do not support the obviousness rejection, for at least the following reasons.

Independent claim 11 has been amended to recite a “microscopic observing apparatus comprising: a probe microscope; an auxiliary microscope; a specimen stage on which is

placed a subject of observation that is to be observed using the probe microscope and the auxiliary microscope, and that allows an absolute position of the subject of observation to be adjusted; a laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation; and a microscope holding member that holds both of the probe microscope and the auxiliary microscope on the specimen stage, ***wherein the auxiliary microscope is located such that a marker formed by the laser light on the subject of observation for positioning the probe microscope is visible.***

The highlighted, amended features are fully supported by the original Specification, e.g., p. 68, l. 6-11 and 22-25. In accordance with amended claim 11, by employing the feature that “the auxiliary microscope is located such that a marker formed by the laser light on the subject of observation for positioning the probe microscope is visible,” the microscopic observing apparatus provides an advantageous effect that, when switching from macro observation to micro observation, positioning of the probe microscope can be made easily and accurately while referring to the marker in a view of the auxiliary microscope. In contrast, the applied references simply do not teach or suggest this claimed feature, as explained in further detail below.

In contrast to the Examiner’s contention, FIG. 52 of Shioda’062 neither discloses nor suggests “a marker formed by the laser light on the subject of observation for positioning the probe microscope,” as recited in amended claim 11. As shown in FIGS. 53A and 54 of Shioda ‘062, laser beams emitted from projection windows 443 and 444 are directed toward the oblique direction with respect to the length of a rigid endoscope 434 (i.e., the oblique direction with respect to an insertion axis O1 of the rigid endoscope 434). Furthermore, as shown in FIG. 54 of Shioda ‘062, the laser beams irradiate points which are not on an extension line of the insertion axis O1. Therefore, as FIG. 52 clearly indicates, the microscope system of Shioda ‘062 cannot see the marker formed by the laser light irradiated on the subject of observation for positioning the probe microscope through a view of an auxiliary microscope 401. In particular, based on FIG. 54 of Shioda’062, one of ordinary skill in the art can easily visualize that, before inserting the rigid endoscope 434 into the subject of observation P, laser beams irradiated from the endoscope 434 will be directed to “air,” and therefore the irradiated point of the laser beams cannot be confirmed through a view of the auxiliary microscope 401. Furthermore, paragraph [0295] of Shioda’062 states that “a field size of the rigid endoscope 434 is calculated in accordance with the emission

indexes 459a2, 459b2 of the image information M2,” which clearly indicates that the emission indexes 459a2, 459b2 are used for scale measurement but not for positional adjustment of the rigid endoscope 434. Accordingly, Shioda ‘062 clearly fails to teach or suggest the feature that “***the auxiliary microscope is located such that a marker formed by the laser light on the subject of observation for positioning the probe microscope is visible.***”

Moreover, the above-noted deficiency of Shioda’062 cannot be cured by incorporating the teachings of Kudo and Shioda’371, since Kudo and Shioda’371 similarly fail to teach or suggest the feature that “***the auxiliary microscope is located such that a marker formed by the laser light on the subject of observation for positioning the probe microscope is visible.***”


For at least the foregoing reasons, Applicants submit that claim 11 and its dependent claims 12 and 16-18, are patentable over the Kudo, Shioda ‘371 and Shioda ‘062 references.

### **CONCLUSION**

Applicants respectfully submit that claims 11-12 and 16-18 of the present application under consideration are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: March 5, 2007

By:   
Jong H. Lee (Reg. No. 36,197)

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**